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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,714	11/12/2003	Kenneth S. Ducker	2841P	9286
29141	7590	09/20/2005	EXAMINER	
SAWYER LAW GROUP LLP			SWARTHOUT, BRENT	
P O BOX 51418			ART UNIT	
PALO ALTO, CA 94303			PAPER NUMBER	
			2636	

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/712,714

Applicant(s)

DUEKER ET AL.

Examiner

Brent A. Swarthout

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-41, 43-49 and 52-58 are is/are rejected.
- 7) ☒ Claim(s) 5, 42, 50-51 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11-12-03.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

a. Claims 1,4,7-8,45,53,55 and 58 are rejected under 35 U.S.C. 102(b) as being anticipated by Nicholl.

Nicholl discloses a system comprising holding mechanism 44 for engaging illumination device 6, and deploying means 41 for deploying illuminating means 3-6.

Regarding claim 4, locking means 40 prevents accidental deployment.

Regarding claim 7, Nicholl teaches use of gravity fed door 38.

Regarding claim 8, holding means 44 is in housing 35.

Regarding claim 45, Nicholl teaches use of plural holding and deploying means (col. 1, lines 64-69).

Regarding claim 58, Nicholl teaches use of deployment interface means 42.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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- b. Claims 2,3,9 and 46-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholl.

Nicholl discloses a system for deploying illumination means as set forth above, except for specifically stating that a clamp contacts the illumination device.

However, since Nicholl teaches that clamp 38/40 contacts weight member 43 which is directly connected to illumination means 3, choosing to have clamp directly connected to means 3 would have been an obvious matter of engineering choice, merely depending on which order the weight and illumination device were loaded into housing 35.

Regarding claim 3, the clamp 38/40 could be considered to be a holding mechanism, since it holds devices 3-6 until release, it being obvious to have holding means contact illumination means for the same reasons as set forth above with regard to claim 2.

Regarding claim 9, aircraft 2 can be considered a housing 2, and the interior of plate 35 would have been a slot that engaged the illumination means in a cylinder.

3. Claims 6, 36, 52 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholl in view of Sciortino et al.

Sciortino teaches desirability of activating a door means by use of solenoid (col. 5, lines 17-30).

It would have been obvious to use an electrical solenoid to open a door in a device as disclosed by Nicholl instead of a pull mechanism, in order that a door could have been more easily opened especially for heavier items in a housing.

4. Claims 10-12,16,18-19,33-34,37-41, 43-44 and 56-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholl in view of Martinez and Anglin, Jr. et al.

c. Nicholl discloses a lighting deployment system as set forth above, except for use of specific lighting means.

i. Martinez discloses use of an illumination device comprising shell with plural sides 14,52, light emitter 27 inside shell for emitting light through plural sides of the shell, except for means for attaching to a surface from sides of the shell.

(1) Anglin teaches desirability of using means 76 to secure to a shell of an illumination device to attach to other surfaces.

It would have been obvious to use attachment means as suggested by Anglin in conjunction with an illumination device as disclosed by Martinez, and to deploy such a system using a technique disclosed by Nicholl, in order to allow an illumination device that was capable of being attached to other devices for a more secure placement to be easily deployed into position.

Regarding claims 11-12, Martinez teaches top half 14 and bottom half 52, which are symmetrical.

Regarding claim 16, Martinez teaches hole in housing for placement of switch contacts 32,34.

Regarding claim 18, Martinez teaches use of power means 42.

Regarding claim 34, choosing to use illumination devices for use in traffic safety would have been obvious matters of intended use.

5. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholl in view of Martinez, Anglin, Jr. et al. and Moore.

Moore discloses use of primary and secondary ribs 64,84 in symmetrical halves of a housing (Fig.5).

It would have been obvious to use ribs as suggested by Moore in conjunction with a housing as disclosed by Martinez, in order to provide greater structural integrity for the housing.

6. Claims 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholl in view of Martinez, Anglin, Jr. et al. and Parashar.

Parashar discloses placement of a solid filler material 57 in an illumination device (Fig.2).

It would have been obvious to place filler as suggested by Parashar inside a housing as disclosed by Martinez, in order to make a housing more ruggedized, in order to make a light less susceptible to breakage when dropped.

Regarding claim 17, Parashar teaches desirability of including a circuit board 59 in an illumination device in order to allow ease of installation and replacement of control circuitry.

7. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholl in view of Martinez, Anglin, Jr. et al. and Laszlo et al.

Laszlo teaches desirability of using notch 76 with contact for engaging charging means for insertion into notch in an illumination device 10.

It would have been obvious to include recharging notch as suggested by Laszlo in conjunction with an illumination structure as disclosed by Martinez and Anglin in order to allow an illumination device to be recharged to provide longer useful life.

Since Laszlo teaches use of recharging port 76 for connection to external power source, it would have been obvious to include a power source externally in conjunction with a device as disclosed by Martinez and Anglin, in order that a device could have been recharged from an external source.

Regarding claims 21-22, use of a circuit board of Laszlo would have been obvious for ease of installation and control of illumination device. Charging adapter plugs also typically include a guide with the notch to allow insertion of a plug, and would obviously have included electrical connection to circuitry.

Choosing to use an O-ring would have been obvious in order to seal openings from moisture and contamination from environmental contaminants.

8. Claims 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholl in view of Martinez, Anglin Jr. et al. and Bond.

d. Bond discloses desirability of using an outer layer 48 outside of a shell portion supporting plural lights 60.

It would have been obvious to use an outer layer as suggested by Bond in conjunction with a light structure as disclosed by Martinez and Anglin, in order to allow the lighting device to be more waterproof so as to be used acceptably in harsh environments.

Regarding claim 29, Bond teaches use of sealing means to make the outer layer watertight (col.2, lines 26-35).

Regarding claim 31, outer layer 48 is transparent (col.2, line 19).

Regarding claim 32, choosing to use a well-known injection molding process to form an outer layer would have been obvious, merely depending on what type of material was chosen for the outer layer, injection molding being an extremely well-known technique for forming low cost plastic structures.

9. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholl in view of Martinez, Anglin Jr. et al and Turboflare.

Turboflare teaches desirability in an illumination device of automatically turning on an illumination device once it is disengaged from a charger/holder.

It would have been obvious to include automatic activation as suggested by Turboflare in conjunction with an illumination device as suggested by Martinez and Anglin, in order that a device could have been ready for operation as soon as it was charged up/released without having to activate specific switch means, thus allowing easier operation.

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the



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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

e. Claims 10-35, 37-41 and 43-44 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16, 23-27, 29-34, 36 and 42 of copending Application No. 10/712,431 in view of Nicholl. Prior filed claims disclose a particular type of lighting device. Nicholl teaches means of deploying lighting devices, one of ordinary skill in the art recognizing that it would have been obvious to deploy lights as suggested by the copending claims by the technique used by Nicholl.

This is a provisional obviousness-type double patenting rejection.

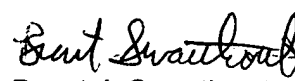
11. Claims 5, 42, 50 and 51 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jigamian, Lazzarini and Hernandez disclose lighting deployment devices.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brent A Swarthout whose telephone number is 571-272-2979. The examiner can normally be reached on M-F from 6:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Hofsass, can be reached on 571-272-2981. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Brent A Swarthout  
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**BRENT A. SWARTHOUT  
PRIMARY EXAMINER**